

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Nils-Erik ENGSTROM

Application No.: 10/580,191

Confirmation No.: 1806

Filed: February 26, 2007

Art Unit: 3637

For: **A JOINT FOR A PANEL**

Examiner: SAFAVI, MICHAEL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejections prior to filing a brief in this matter.

The Invention

The invention of the sole independent claim (claim 1) is directed to a joint between two panels and can best be understood by reference to the original disclosure, for example, originally filed Figs. 1a-1b which is annotated herein as Exhibit A. As specifically set forth in independent claim 1, the joint comprises a first edge, comprising a groove 11, and a second edge provided with a tongue 21, as shown in annotated Fig. 1a. The second edge further comprises an upper groove 12 and a joining profile 3, where the joining profile 3 comprises an elastic material and is provided with at least one tongue 37 and an intermediate section 33. The joining profile 3 is so configured as to allow the joining profile to be located in the upper portion of the joint (see Fig. 1b) between the two panels.

The Rejection

1. Claims 2-4, 6, 7 and 12-13 are rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement.
2. Claims 2-4, 6, 7 and 12-13 are rejected under 35 U.S.C. 112 second paragraph as allegedly being indefinite for failing to particular point out distinctly claimed the subject matter which applicant regard as the invention.
3. Claims 1-7 and 12-13 stand rejected under 35 U.S.C. 102 (a) as allegedly anticipated by U.S. Patent Publication No. 2003/0024199 to Pervan et al. (hereinafter Pervan).

Applicants Arguments

1. The rejection of the claims under 35 U.S.C. 112, first paragraph

As to the allegation that claims 2-4, 6, 7 and 12-13 fail to comply with the written description requirement, Applicants note that the written description not only includes the specification but also the drawings which are a part thereof.

While the Examiner alleges that there does not appear to be a second upper side groove along the second edge, Applicants direct the Board's attention to the previous description of Fig. 1a as annotated in Exhibit 1 which clearly shows the second edge as being the right hand side of Fig. 1a (as including the tongue 27) and that element 12 denotes the upper side groove.

Applicants note that in claim 2 the term "second upper side groove" is to use to delineate such a groove from the term "upper side groove" 12 in the first edge as clearly recited therein. Thus, there is clearly a [first] upper side groove 12 in the first edge and a [second] upper side groove 12 in the second edge as clearly disclosed in Applicants' original description of the invention; See also the specification, page 8, lines 7-8. Accordingly, the specification clearly complies with the written description requirement and reversal of the rejection is warranted.

2. The rejection of the claims under 35 U.S.C. 112 second paragraph

While the Examiner alleges that these claims are vague and indefinite, firstly Applicants points out that Congress has left it solely to Applicants to recite the subject matter that they

regard as their invention (35 U.S.C 112, second paragraph). See also *In re Borkowski*, 164 USPQ 642, 645 (CCPA 1970).

There are two upper side grooves in the claimed joint. A [first] upper side groove 12 in the first edge (see Fig. 1a and specification page 8) and a [second] upper side groove 12 in the second edge (see Fig. 1a and the specification page 8) and thus the recitation of an “upper side groove” in the first edge and a “second upper side groove” in the second edge is as Applicants have intended and this language means exactly what they regard as the subject matter of their invention. Secondly, with regard to line 3 of claim 2 which presents the term “a first, and a second, snapping tongues” the Examiner questions whether there are a “plurality” of first snapping tongues and a plurality of second tongues. Applicant never uses the term recited by the Examiner “plurality” anywhere in the claim and thus the Examiner appears to be requesting Applicant to opine on terms not used by Applicant in his claims. This is not a proper basis for rejecting the claims under 35 U.S.C. 112 second paragraph. As to the recitation in lines 4-5 of claim 2, that “the joining profile be so configured so as to allow each of the first and second snapping tongues to be fitted into the first and second and second upper side grooves of the two, joined adjacent panels”, and to the Examiner’s query as to how it is not clear, Applicant again respectfully directs the Panel’s attention to Fig. 1a and the assembled joint and joining profile in Fig. 1b as to how this is achieved. Lastly, with regard to the Examiner’s final query as to claim 2, Applicant only directs the Board’s attention to the fact that dependent claims are to be in compliance with 35 U.S.C. fourth paragraph and further limit the claim from which they depend. Thus, the tongue of the joining profile has now been further limited in the to be “at least” terminology to be specifically a “first, and a second” but also has further limited the style of the tongue to be “snapping” where dependent claim 1 is not so limited. Accordingly to claim 2 is in compliance with 35 U.S.C. 112, second paragraph.

The Examiner again sets up a straw man argument with regard to claim 3 as alleging that “mating surfaces” is the same as a “a first edge and a second edge” introduced in claim 1. This is not true. It is basic patent law that different words in different claims mean different things. This is the basis of claim differentiation. The terms first edge and second edge only define the

ends of the panel. Claim 3 defines “mating surfaces,” e.g. see Fig. 1b, which are only limited portions of the “ends” of the panel. Thus, the term “mating surfaces” does not mean the same thing as the “first and second edges”. Claim 3 is therefore in compliance with 35 U.S.C. 112.

The rejection of claim 7 appears to be made solely because the Examiner has omitted the phrase “a portion” of a panel from his reading of the claim Applicant is not defining the “whole” panel but here “a portion of the panel” in the portion between the upper side groove and the panels respective distal edge which has a recess (e.g., See 14 in Fig. 3a) (See also specification, page 10, lines 2-4) therefore claim 7 complies with 35 U.S.C. 112 second paragraph.

The Examiner’s query as to claim 12 is specious. Applicant has previously pointed out that claim 2 (upon which claim 12 depends) recites a “upper side groove” and a “second upper side groove”. Therefore, the term “the upper side groove” refers to the term “upper side groove” in claim 2. With regard to the term “the distance...” Applicants again point out that the Examiner is only reading a portion of the term as recited in the claim. Applicants again respectfully direct the Panel’s attention to the specific recitation of claim 12 that “between the first and second groove edge surfaces a predetermined distance is present, the distance being so configured...”. Thus, it is not merely a “distance” but the distance between two elements that is being configured. As to the query to line 4, the snapping tongue is a snapping tongue that fits into “upper side groove” previously discussed above. Thus, claim 12 clearly complies with 35 U.S.C. 112, second paragraph.

The limitations of claim 13 refer to claim 12 (previously discussed) and thus “the upper side groove” is the groove provided in the panel having a first groove edge and a second groove edge surface in which an undercut is present. Again, it appears the Examiner fails to read the claims in compliance with statute (35 U.S.C. 112, fourth paragraph) such that each further dependent claim further limits the claims from which it depends. Claim 13 accordingly complies with 35 U.S.C. 112 second paragraph. Reversal of all rejections under 35 U.S.C. 112 second paragraph is therefore requested.


3 The rejection of claims 1-7 and 12-13 under 35 U.S.C. 102 (a) as being anticipated by Pervan.

In order to constitute "anticipation", the cited reference must teach each and every element of the claim, see generally MPEP Section 2131. While the Examiner refers to Figs. 8c, 10b, 15c and 17c as disclosing a joint between two panels, there is no joining profile in Pervan. While the Examiner refers to 55 as "a joining profile", Pervan clearly discloses 55 as a sealant not a joining profile. Moreover Pervan does not disclose in any of Figs. 8c, 10b, 15c, 17c, or elsewhere, a second edge further comprising an upper side groove or even a first edge comprising an upper side groove. In each of Figs. 8c, 10, 15c and 17c, the panels have no upper grooves of any type (see Figs. 8e, 10, 15e and 17e, respectively, and in each case sealant 55 is below the upper sides of the panel and is internal of the panel upper sides. Because Pervan does not even teach anticipation of independent claim 1, it cannot possibly render anticipatory any of dependent claims 2-7 and 12-13. Reversal of the rejection is therefore respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith, or credit any overpayment, to our Deposit Account No. 14-1437, under Order No. 8688.048.US0000.

Dated: January 6, 2011

Respectfully submitted,

By 

Thomas P. Pavelko

Registration No.: 31,689
NOVAK DRUCE & QUIGG LLP
Correspondence Customer Number: 74217
300 New Jersey Ave, NW
Fifth Floor
Washington, DC 20001
202-659-0100 telephone
Attorney for Applicant

EXHIBIT 1

Fig. 1a

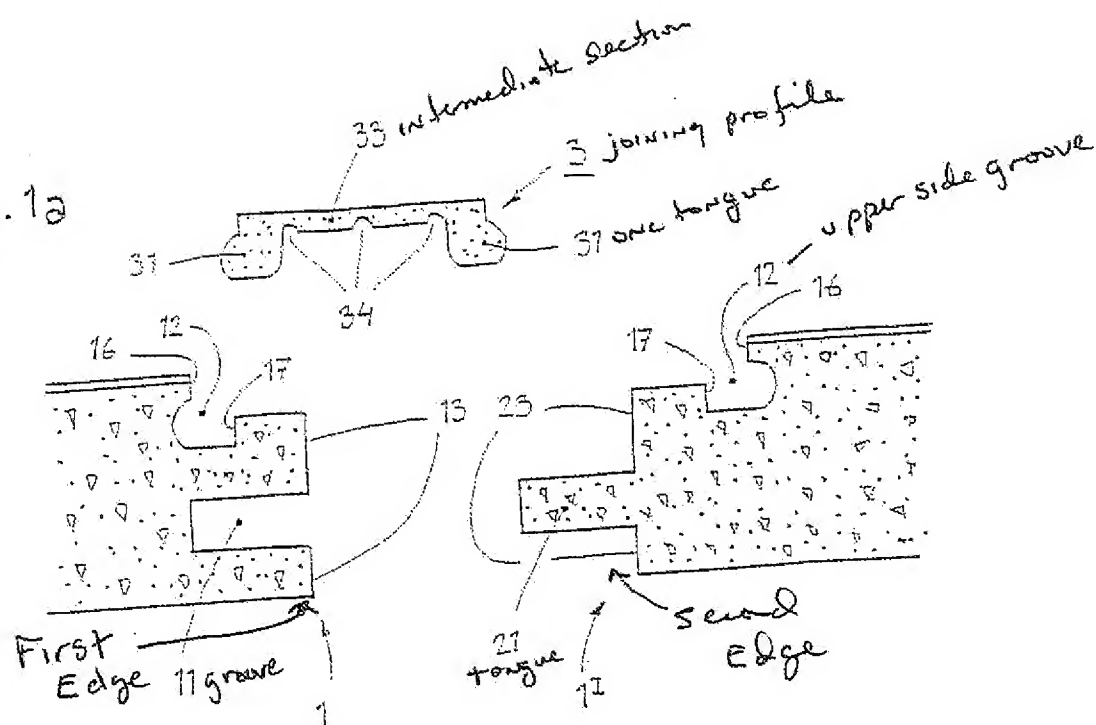


Fig. 1b

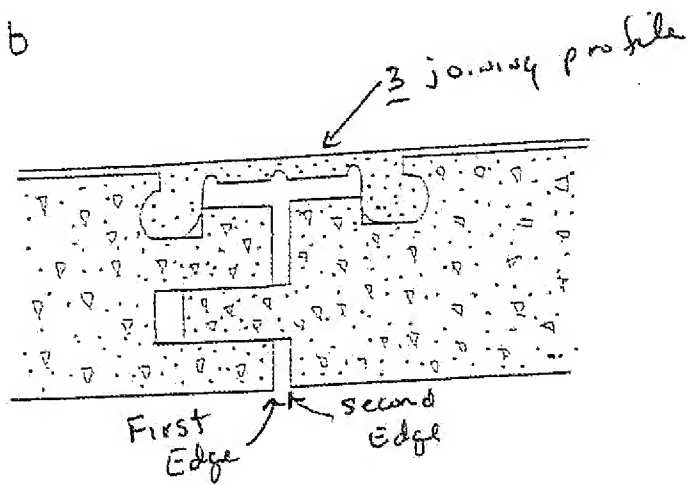


Fig. 1c

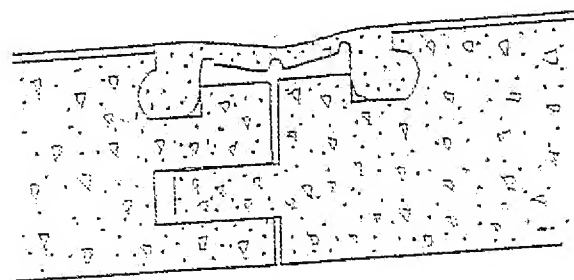


Fig. 2

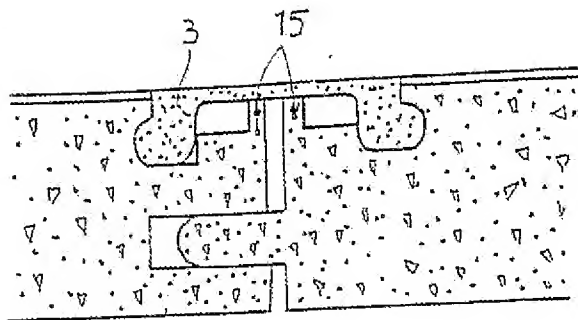


Fig. 3a

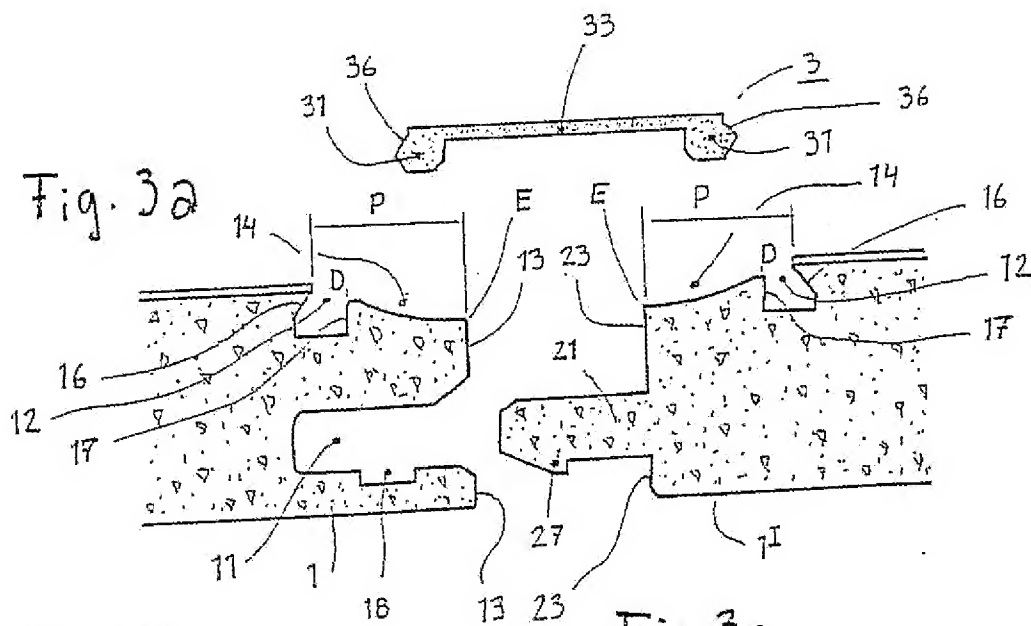


Fig. 3b

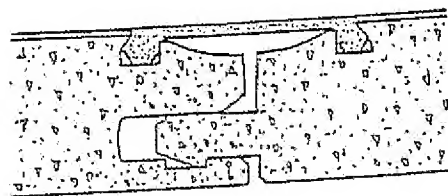


Fig. 3c

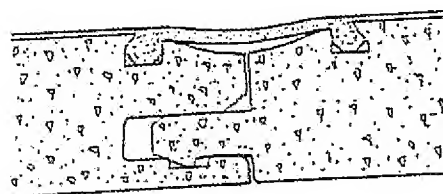


Fig. 4

